

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** MICHAEL D. BROOME

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Appeal No. 97-2968  
Application 08/531,077<sup>1</sup>

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ON BRIEF

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Before COHEN, MEISTER and FRANKFORT, **Administrative Patent Judges**.

MEISTER, **Administrative Patent Judge**.

**DECISION ON APPEAL**

Michael D. Broome (the appellant) appeals from the final rejection of claims 1 and 4-15, the only claims remaining in the application.

We REVERSE.

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<sup>1</sup> Application for patent filed September, 20 1995.

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The appellant's invention pertains to a roll-up divider for compartmentalizing a room. Independent claims 1 and 6 are further illustrative of the appealed subject matter and copies thereof may be found in the appendix to the appellant's brief.

The references relied on by the examiner are:

Moss	4,084,683	Apr. 18, 1978
Roller	4,298,048	Nov. 3, 1981

Claims 1 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Roller.

Claims 4-12, 14 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Roller in view of Moss.

The examiner's rejections are explained on pages 3-6 of the answer. The arguments of the appellant and examiner in support of their respective positions may be found on pages 5-11 of the brief and pages 6-8 of the answer.

#### **OPINION**

Initially, we note that on pages 10 and 11 of the brief the appellant raises questions as to the propriety of the examiner's requirement for correction of the drawing. However, under 35 U.S.C. § 134 and 37 CFR § 1.191, appeals to the Board of Patent Appeals and Interferences are taken from the decision of the primary examiner to reject claims. We exercise no general

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supervisory power over the examining corps and decisions of primary examiners to require corrections to the drawings are not subject to our review. **See Manual of Patent Examining Procedure** (MPEP) §§ 1002.02(c) and 1201 (6th ed., Rev. 3, Jul. 1997); **cf. In re Mindick**, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967) and **In re Deters**, 515 F.2d 1152, 1156, 185 USPQ 644, 648 (CCPA 1975). Thus, the relief sought by the appellant would have properly been presented by a petition to the Commissioner under 37 CFR § 1.181.

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and by the examiner in the answer. As a consequence of this review, we will not sustain either of the above-noted rejections.

Considering first the rejection of claims 1 and 13 based on Roller alone, the answer states that:

What Roller does not show is the polyurethane coating upon the belt. However, since there are other coating compositions that are known in the art that would perform equally as well, as also stated within the specification of the instant application on page 7 lines 23-28, it is the position of the examiner that it would have been a mere [matter of] design choice to produce the belt having a polyurethane coating in order to increase the resistance to heat transfer and damage

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caused by the resulting frictional forces created by the curtain and belt winding and unwinding against each other. [Page 4.]

We will not support the examiner's position. As stated on page 7 of the specification the polyurethane coating on the belt "grips to the vinyl material so as to limit slippage of the curtain relative to belts 35" (lines 22-23). The examiner recognizes this. Nevertheless, the examiner takes the position that because other coating compositions are "known" in the art that would perform "equally as well" (apparently because the appellant further states on page 7, lines 25 and 26 of the specification that "other coating compositions which adhere to vinyl could be substituted"), the particular coating composition can be dismissed as a matter of design choice. The problem is, however, that the examiner has provided no evidence whatsoever to support the position that there are other compositions known in the art which would perform equally as well as polyurethane as the examiner asserts.<sup>2</sup> The appellant does not state that such other compositions were *known* in the art as the examiner appears

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<sup>2</sup> "A rejection based on section 103 clearly must rest on a factual basis, and these facts must be interpreted without hindsight reconstruction of the invention from the prior art. . . . [The examiner] may not . . . resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in . . . [the] . . . factual basis." *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968)).

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to imply but, instead, more broadly states that other coating compositions which possessed the property of "adhering" to the vinyl could be substituted. This latter statement by appellant can be construed to mean nothing more than *if* other compositions were discovered which possessed the property of "adhering," then they too can be utilized.

The examiner also notes that Roller in line 44 of column 4 states that the belts may be "Vinyl Coated Polyester" and urges that vinyl is "inclusive" of polyurethane. However, the mere fact that, as a broad proposition, polyurethane might be considered to be a vinyl does not provide a sufficient factual basis for establishing the obviousness of the particular "vinyl," i.e., polyurethane, within the meaning of 35 U.S.C. § 103. This being the case we will not sustain the rejection of claims 1 and 13 under 35 U.S.C. § 103 as being unpatentable over Roller.

Turning to the rejection of claims 4-12, 14 and 15 based on the combined teachings of Roller and Moss, it is the examiner's position that it would have been obvious to form the rollers 58 of Roller as crowned rollers in view of the teachings of Moss "in order to insure proper guiding and centering of the belt material around the belt take-up member" (answer, page 5). In support of this position the answer states that:

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The Roller reference uses a regular cylindrical shape which may allow axial slippage of the belts with respect to the rollers, however, Moss discloses a 'crowned' roller shape that aids in the correct positioning of the flat elongated belt-type material as stated in column 4 line 15 through column 5 line 25. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the roller of Roller by shaping it in the form of a 'crowned roller', as taught by Moss, in order to insure proper guiding and centering of the belt material around the belt take-up member. [Page 8.]

We will not support the examiner's position. The mere fact that the substitution of crowned rollers such as that taught by Moss at 84 for the straight rollers 58 of Roller would result in proper guiding and centering of the belt does not serve as a proper motivation or suggestion to combine the teachings of these references. Instead, it is the teachings of the prior art which must provide the motivation or suggestion to combine the references. **See *In re Fritch***, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). Here, we find no such suggestion. While the examiner is correct in noting that Moss utilizes crowned rollers 84 for correcting the position of the belt-like material 70 (i.e., ribbon) as it passes through a high speed band printer, we must point out that this correction is done in the context of correcting misalignment of the ribbon due to (1) forces caused by the proximity of the paper 41 as it

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passes along a horizontal path through the printing station or (2) vector forces of the print hammers striking against the ribbon during the printing operation (see column 4, lines 34-43). Absent the appellant's own teachings, we are at a loss to understand why one of ordinary skill in the art would have been motivated to single out the crowned roller "shape" from the disparate teachings of Moss and incorporate it into the device of Roller for the purpose of facilitating winding of Roller's belts 30 about belt take-up member 46. The examiner may not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), *cert. denied*, 484 U.S. 823 (1987) and *In re Kamm*, 452 F.2d 1052, 1057, 172 USPQ 298, 301-02 (CCPA 1972).

Since we are of the opinion that the examiner has impermissibly relied on the appellant's own teachings in arriving at a conclusion of obviousness, we will not sustain the rejection of claims 4-12, 14 and 15 under 35 U.S.C. § 103 as being unpatentable over Roller in view of Moss.

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The examiner's rejections of claims 1 and 4-15 under  
35 U.S.C. § 103 are reversed.

**REVERSED**

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
JAMES M. MEISTER	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	

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